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08/339,976	11/15/94	DARERKO	N	T2591

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ART UNIT	PAPER NUMBER
2308	9

DATE MAILED:
08/29/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

See ATTACHED
- office action summary
- notice of references cited
- office action
- prior art

8/21/96
JMGrover

PTOL-90 (Rev. 6/84)

1 - PATIENT APPLICATION FILE COPY

Office Action Summary	Application No. 08/339,977	Applicant(s) Daberko et al.
	Examiner John Michael Grover	Group Art Unit 2308

☒ Responsive to communication(s) filed on *Apr 15, 1996* .

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-13* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-13* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Response to Amendment

1. This action is a response to the amendment filed on 4/15/96. Claims 1-13 are pending The examiner notes the Amendment properly addressed the title, and the 35 U.S.C. §112(2) rejection, thus they are withdrawn. Further, a Terminal Disclaimer has been filed, and the Double Patenting rejections are withdrawn. The Objections to the Drawings remain.

Response to Arguments

2. Applicant's arguments filed 4/15/96 have been fully considered but they are not persuasive.

First, the Applicant argues the previous rejection of claim 1 does not make a *prima facie* case of obviousness (Amendment pp. 7-8, in regard to claim 1), however the Applicant fails to state why the rejection does not meet its burden (the Applicant mentions *hindsight reasoning*, but never applies the argument to the instant rejection).

In response, the examiner submits it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Therefore, the claim limitations rejected in claim 1 are maintained by the examiner.

Second, the Applicant argues it would not have been obvious to substitute Flash Memory into the teachings of Barker, Ball et al., and Microsoft because the prior art does not suggest the desirability of such a change (pp.9, in regard to claims 3-4, 6-8, 9-11, and 13).

In response, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 19880; *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner's rejection clearly stated, "the substitution is an alternate memory that is versatile and portable...[and] it is well known in the art." In support of that assertion, the examiner submits multiple references teaching Flash Memory is old and well known in the art.

Holzer (DE 42 07 447 A 1) teaches using EEPROM (Flash) memory in a dictation system (Fig. 1, item 39; page 5, paragraph 4 of the translation). Sudoh et al. (5,499,316), Sudoh et al. (5,357,595), and Yamamoto et al. (5,056,145) all teach the use of IC memory to store and instantaneously access sound data on hand-held recording devices. Masuoka, "TECHNOLOGY TREND OF FLASH-EEPROM" teaches Flash Memory can and most likely will replace hard and floppy disk storage (abstract). Barre, "FLASH MEMORY, MAGNETIC DISK

REPLACEMENT?" teaches flash memory technology appears to offer even better functionality in certain areas of bulk storage (abstract).

Therefore, the examiner maintains it is obvious to substitute Flash Memory into the teachings of Barker, Ball et al., and Microsoft because the substitution is an alternate memory that is versatile and portable and it is old and well known in the art." And, therefore, the claim limitations rejected in claims 3-4, 6-8, 9-11, and 13 are maintained by the examiner.

Third, the Applicant argues it would not have been obvious to substitute ROM into the teachings of Barker, because Flash Memory is not obvious (pp.10, in regard to claims 4, 11, and 13).

The examiner is unsure of how the connection supports the argument, however, in response the examiner maintains that using ROM to store microprocessor instructions is very old and well known in the art of microprocessor design.

Therefore, the examiner maintains it would have been obvious to one of ordinary skill in the art of CPU design to specify the instruction memory of the CPU taught by Barker, be ROM because it is advantageously helpful to have the instruction set stored in a place where it cannot be changed by a instruction "accidentally" writing to memory where the critical instructions are stored. Further, the use of ROM for instruction sets is very well know in the art.

And, therefore, the claim limitations rejected in claims 4, 11, and 13 are maintained by the examiner.

Fourth, the Applicant argues that because the instant invention does a self test only if primary power fails, Ball et al. does not teach the self test (pp. 12, in regard to claim 8).

In response, the examiner submits (a) the limitation of the self test in response to a primary power failure is not claimed, and (b) the argument itself is misguided because Ball et al. teach the activation of a self test whenever the system first receives power. Therefore, it would have been obvious to one of ordinary skill at the time of the invention to include the self test as taught by Ball et al. in all cases where power is activated in any digital storage system.

Therefore, the examiner maintains the rejection of claims 8.

Fifth, the Applicant argues the nature of Flash Memory precludes a rejection based on a memory map in conventional memory, as taught by Plunkett, Jr. (pp. 13, in regard to claims 5, 9, and 12).

In response, the examiner submits that such argument is misguided. The examiner explicitly stated that it would be obvious to one of ordinary skill in the art of computer programming at the time the invention was made to simply add the instruction to clear the memory map. Please note that a programmed memory map is a simple logical construct used in programming. The program then instructs lower level operating system calls to handle actual physical writing and reading of memory, i.e. the drivers for flash memory would be required to handle the specifics of physical erasing, reading and writing.

Therefore, the examiner maintains the rejections of claims 5, 9, and 12.

Sixth, the Applicant argues "nearly instantaneous" access is not taught by Plunkett, Jr., because the instant invention jumps to the selected area (pp. 13-14, in regard to claim 12)..

In response, the examiner submits that the claimed language is "indexing switching means for moving between the index points to enable the user to rapidly recall indexed messages" and not "jumping." Plunkett, Jr. teaches the ability to move within the memory map by way of jumping (Fig. 6B) which provides for extremely rapid recall, i.e. the time it takes to access memory. This clearly reads on the claim language.

Therefore, the examiner maintains the rejections of claim 12.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-4, 6-8, and 10-11, are rejected under 35 U.S.C. § 103 as being unpatentable over Barker (5,398,220) in view of Ball et al. (5,394,445) and), Microsoft Press Computer Dictionary (Reference PTO 892).

As per claims 1, 6, and 10, the claim limitations rejected in paper 5, based on Barker and Microsoft, are incorporated herein but for the newly added claim limitations of Flash Memory and a separate record switch.

Please note, Barker does not teach the digital recording device including Flash Memory. However, Ball et al. teaches recording messages on Flash Memory as using Flash or EEPROM Memory to accommodate voice, data and program storage (col. 5, lines 61-66).

Therefore, it would have been obvious to one of ordinary skill in the art of hand held recording devices at the time the invention was made to substitute the digital CMOS memory as taught by Barker (col. 5, line 13), for the Flash Memory as taught by Ball et al., because (a) the substitution is an alternate memory that is versatile and portable, and (2) the substitution is old and well know in the art.

Further, it would have been obvious to one of ordinary skill in the art of hand held recording device design to use a separate record button as claimed, in the hand held recording device as taught by Barker, because to do so is an engineering design choice tradeoff between cost and design that is old and well known in the art.

As per claims 2-4, 7-8, and 11, the claim limitations rejected in paper 5 are incorporated herein.

5. Claims 5, 9, and 12-13 are rejected under 35 U.S.C. § 103 as being unpatentable over Barker (5,398,220) in view of Ball et al. (5,394,445), Microsoft Press Computer Dictionary (Reference PTO 892) and Plunkett, Jr. (4,468,715).

As per claims 5 and 12, the claim limitations rejected in paper 5, based on Barker, Microsoft, and Plunkett, Jr., are incorporated herein but for the newly added claim limitations of Flash Memory and a separate record switch.

Please note, Barker does not teach the digital recording device including Flash Memory. However, Ball et al. teaches recording messages on Flash Memory as using Flash or EEPROM Memory to accommodate voice, data and program storage (col. 5, lines 61-66).

Therefore, it would have been obvious to one of ordinary skill in the art of hand held recording devices at the time the invention was made to substitute the digital CMOS memory as taught by Barker (col. 5, line 13), for the Flash Memory as taught by Ball et al., because (a) the substitution is an alternate memory that is versatile and portable, and (2) the substitution is old and well know in the art.

As per claims 9 and 13, the claim limitations rejected in paper 5 are incorporated herein.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

7. The examiner requests any subsequent amendments amending claims, include a complete copy of current claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Grover whose telephone number is (703) 305-3863.

JMG

John Michael Grover
Assistant Patent Examiner
August 21, 1996

ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINER
ART UNIT 2308